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10/625,752	07/23/2003	Steven Weinstein	TVW/APP23USC1	8134

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EXAMINER	
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ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/625,752	WEINSTEIN ET AL.	
	Examiner	Art Unit	
	JASMINE STOKELY-COLLINS	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 18-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 18-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 1, applicant argues that Shoff and Merriman do not disclose of suggest that the user explicitly selects what interactive information will be displayed in response to particular broadcast content. The examiner disagrees. Shoff teaches a multiple user-selectable elements in figure 8b that "enable selection of different types of supplemental content" (col. 11 ll. 25-26), which give the user the ability to explicitly select interactive information.

Regarding claim 16, applicant argues that neither Shoff nor Merriman disclose or suggest altering broadcast content according to personalized indicia. The examiner disagrees. Merriman teaches choosing which advertisements to display based on personalized indicia. Shoff teaches supplemental content comes from both a headend and an ISP (see fig. 4). The supplemental content, when in the form of advertisements, that would come from Shoff's headend are broadcast content and therefore the combination of Shoff in view of Merriman results in broadcast content (supplemental content/ads from the headend) being altered according to personalized indicia. Applicant further argues that Shoff in view of Merriman does not teach he concept of personalized indicia being carried with the out-of-band portion of a TV signal. The examiner adds reference Yuen which teaches sending information used to monitor viewing habits in the VBI of a broadcast signal. In the system taught by Shoff in view of

Merriman, cookies are used as information used to monitor viewing habits. The combination of these teachings results in sending Merriman's viewer habit monitoring mechanism (cookie) in the VBI in the situation where the supplemental content comes from the headend (see fig. 4 of Shoff el. 52).

Claim Objections

2. Claims 1-2 are objected to because of the following informalities:

Line 13 of claim 1 recites "the user selectable element". It is unclear which user selectable element applicant is referring to, as two user selectable elements are claimed in lines 8 and 10 of claim 1.

Line 2 of claim 2 recites "said user selectable element". It is unclear which user selectable element applicant is referring to, as two user selectable elements are claimed in lines 8 and 10 of independent claim 1, from which claim 2 depends.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-7, 9-10, 13, and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al (US 6,240,555 B1).

Regarding claim 1, Shoff teaches an information system (interactive entertainment system, abstract), comprising:
a controller (fig. 4 el. 62: viewer computing unit), for generating an image representative signal adapted for use by a display device (col. 7 ll. 9-18);
a broadcast interface for applying broadcast information to a controller (col. 8 ll. 4-14); and
an interactive information interface for applying interactive information to said controller (col. 8 ll. 14-18);
said controller including said broadcast information (video program), said interactive information (col. 1 ll. 64-col. 11 ll. 47, where fig. 6 el. 164 and 170 illustrate the steps that a user takes to get to the screen shown in fig 8b. The supplemental content is the target resource and col. 9 ll. 23-26 disclose a target resource is located at an independent service provider) and a user selectable element (fig 8b el. 212-221: soft buttons) in said image representative signal such that corresponding presented imagery includes an interactive portion, a broadcast portion and a user selectable element (fig. 8 b shows a screen divided into an interactive menu, broadcast program, and user selectable soft buttons),
wherein said interactive information interface retrieves information from a network (fig. 4 el. 82) in response to the reception of broadcast information (the retrieved interactive information corresponds to the program the user is viewing), the information being selected by the user using the user selectable element (col. 11 ll. 25-44).

Regarding claim 2, when read in light of claim 1, Shoff further teaches said user selectable element comprises a hyperlink having associated with it an
object (col. 11 ll. 218-220);
said interactive information interface, in response to a selection of said hyperlink, includes said object associated with said hyperlink within said interactive information (fig 8c, col. 11 ll. 66-col. 12 ll. 11).

Regarding claim 3, when read in light of claim 1, Shoff further teaches an input device for selecting said user selectable element, said input element
comprising at least one of a keypad (keyboard), a pointing device (mouse) and a graphical user interface (col. 7 ll. 14-18).

Regarding claim 5, when read in light of claim 1, Shoff further teaches said interactive information interface comprises a network access device (fig. 5 el. 100, col. 8 ll. 14-18).

Regarding claim 6, when read in light of claim 5, Shoff further teaches said network access device includes a web modem (col. 8 ll. 14-18).

Regarding claim 7, when read in light of claim 1, Shoff further teaches said interactive portion of said imagery comprises objects (supplemental content) retrieved from a network and displayed in a first image panel (fig. 8b menu area and fig. 8c menu area and merchandise area); and
said broadcast portion of said imagery comprises broadcast video imagery displayed in a second image panel (fig. 8b and 8c program area 210).

Regarding claim 9, when read in light of claim 1, Shoff further teaches said user selectable element includes a control button for selecting a preference (soft button 217), said preference being used to determine how said broadcast information is presented in relationship to said interactive information (col. 11 ll. 12-24).

Regarding claim 10, when read in light of claim 7, Shoff further teaches said first image panel is used to display web content (col. 10 ll. 59-67 state supplemental content is displayed in the remaining portion of the screen not taken by video programming. Col. 7 ll. 26-31 and 55-60 teach supplemental content being web content).

Regarding claim 13, when read in light of claim 7, Shoff further teaches said retrieved information is displayed in said first image panel (fig. 8b menu area and fig. 8c menu area and merchandise area).

Regarding claim 21, when read in light of claim 1, Shoff further teaches said user selectable element includes a control button for selecting a preference (soft button 217), said preference being used to select from a set of predetermined display formats that determine how displayed broadcast information is presented in relationship to displayed interactive information (col. 11 ll. 12-24).

Regarding claim 22, when read in light of claim 1, Shoff further teaches said user selectable element includes a control button for selecting a preference (soft button 217), said preference being used to alter a predetermined display format that determines how displayed broadcast information is presented in relationship to displayed interactive information (col. 11 ll. 12-24).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4, 11, 14-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 6,240,555 B1) in view of Merriman et al (US 5,948,061).

Regarding claim 4, Shoff teaches the information system of claim 1.

Shoff does not teach data memory for storing a user preference.

Merriman teaches a method of delivering targeted advertising to viewers in which a database stores the amount of times a user accesses an ad (col. 6 ll. 17-19). The amount of times a user accesses an ad (whether the user never selects a particular ad or if he selects it frequently) reflects his preferences. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Merriman's method of targeted advertising in the networks disclosed in Shoff for the benefit of maximizing the likelihood that a user will respond to an advertisement and in turn maximizing the revenue made off of advertisements.

Regarding claim 11, when read in light of claim 4, Merriman further teaches said user preference stored in said data memory is accessible to at least a networked server to which the preference relates (col. 5 ll. 50-60).

Regarding claim 14, when read in light of claim 1, Merriman further teaches data memory for storing a user preference (database), said user preference being stored in said memory by a web site interacting with said interactive information interface (ad server performs a reporting process, col. 4 ll. 37-42).

Regarding claim 15, when read in light of claim 1, Merriman further teaches data memory (database, col. 5 ll. 50-60) for storing a user preference. Shoff teaches presenting web content with a program in col. 7 ll. 26-35 and col. 9 ll. 54-59 teach accessing this content by user selection of an icon. Merriman teaches advertisements being stored on networks in col. 2 ll. 17-19, where Shoff fig. 4 el. 54 and 86 show similar storage for any supplemental content on the ISP host and headend. Merriman also teaches in col. 4 ll. 37-42 that an ad server updates a counter in a database each time an ad is displayed. The combination of Shoff in view of Merriman results in said user preference being stored in said memory in response to user interaction via said user selectable element.

Regarding claim 20, when read in light of claim 15, Merriman further teaches retrieving preferences and formatting the received selected web content and received broadcast content based on those preferences (col. 1 ll. 29-39 teach displaying an on-line advertisement by placing banners at an appropriate location on a browser. Merriman further teaches that an advertisement is selected based on preferences contained in a database in col. 5 ll. 50-col. 6 ll. 59).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 6,240,555 B1) in view of Nakano et al (US 5,745,109).

Regarding claim 8, when read in light of claim 7, Shoff teaches the system of claim 7 where multiple panels are simultaneously displayed.
Shoff does not disclose said first panel is at least partially transparent and overlaps said second panel.
Nakano teaches a first panel is at least partially transparent and overlaps a second panel (Figure 6A). It would have been obvious to one ordinarily skilled in the art, at the time the invention was made, to combine the teachings of Shoff and Nakano in order to simultaneously view both windows by seeing the broadcast image through the interactive window (as stated by Nakano column 5 lines 58-60) and therefore being able to maximize the viewing area of the broadcast image.

8. Claims 16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 6,240,555 B1) in view of Merriman et al (US 5,948,061), and further in view of Yuen et al (US 5,532,732).

Regarding claim 16, Shoff teaches a method of displaying information comprising: initializing a display system (page 2 section 0019); receiving selected web content (page 2 section 0017-19); receiving broadcast content (page 2 section 0019);

formatting received web content and received broadcast content into video information (figure 8c, page 7 section 0080); and

displaying video information to simultaneously produce interactive information having a user selectable element (figure 8c element 237, page 7 section 0080) and a television broadcast (figure 8c).

Shoff does not teach receiving personalized indicia;

Altering the broadcast content according to the personalized indicia; and formatting received personalized indicia into video information;

Regarding limitation "altering the broadcast content according to the personalized indicia", Merriman meets this limitation by selecting advertisements sent through a network (col. 1 ll. 8-11) based on personalized indicia (cookies). In Shoff's system, there are two networks, one being a broadcast network which would also include commercials as is known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

incorporate Merriman's method of targeted advertising in the networks disclosed in Shoff for the benefit of maximizing the likelihood that a user will respond to an advertisement and in turn maximizing the revenue made off of advertisements. Regarding limitation "receiving personalized indicia within at least an out-of-band portion of a television signal", Merriman teaches sending personalized indicia in the form of a web browser cookie (column 5 lines 18-28) in which the ad server (advertisers) use the collected information from the cookie for future delivering of targeted ads to corresponding user (column 5 line 65 - column 6 line 60). The combination of Shoff in view of Merriman results in both the internet and a broadcast television (see fig. 4 of Shoff, el. 74 and 82) network storing and sending supplemental internet content which would include any web advertisements. It is well known in the art to use the vertical blanking interval of a television signal to monitor audience viewing habits, as disclosed in Yuen col. 1 ll. 66-col. 2 ll. 4. In the system taught by Shoff in view of Merriman, this monitoring is done using web browser cookies. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Merriman's cookies in the VBI, as taught by Yuen for the benefit of using an existing communication channel to monitor the viewing of supplemental content provided through Shoff's broadcasting network.

Regarding claim 18, when read in light of claim 16, Merriman further teaches sending targeted advertisements to users (i.e. "retrieving personalized

information") based on user profiles and the number of times a user has been exposed to a particular advertisement (column 5 line 50-column 6 line 59), where cookies ("personalized indicia") are used to determine and access this information (column 5 lines 19-21). Therefore, limitation "retrieving personalized information based on said personalized indicia" is met.

Regarding claim 19, when read in light of claim 16, Merriman further teaches said personalized indicia is a web browser cookie (col. 5 ll. 18-28).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASMINE STOKELY-COLLINS whose telephone number is (571) 270-3459. The examiner can normally be reached on M-Th 9:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jasmine Stokely-Collins/
Examiner, Art Unit 2623

/Andrew Y Koenig/
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